



REMARKS/ARGUMENTS

Responsive to the Office Action mailed July 5, 2006:

- A. The Office Action rejected claims 1-3, 5-14 and 16-17 under 35 USC 103(a) as being unpatentable over LaBounty in view of Ramun. Applicant respectfully traverses the rejection.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.¹ If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.²

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.³

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

There is no motivation to combine the references.

The Office Action states:

LaBounty et al. does not show a shim. However, Ramun teaches the use of a shim 70 for the purpose of adjusting the distance between the blades because of the decrease in width caused by wear. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the device of LaBounty et. al by providing the shim as taught by Ramun in order to obtain device that adjusts the distance between the guide and the upper jaw.

With respect, Applicant disputes this statement.

¹MPEP Sec. 2142.

² Id.

³Id. (emphasis supplied)

As stated in the MPEP, and taught in many Federal Circuit cases, there must be a motivation to combine the references.

LaBounty does not teach any motivation to combine Ramun with it. LaBounty already has a mechanism “that adjusts the distance between the guide and the upper jaw.” Col. 5 lines 51-57:

Before beginning operation, the guides 68, 95 may initially be set at a clearance of about 0.01 to 0.02 inches from the upper jaw by means of a feeler gauge. This clearance may be adjustable as the guide becomes worn by turning bolt ends 78, 102 with a wrench. This clearance also allows the guides 68, 95 to clear the wear surfaces 44, 46 when the upper jaw is opened.

Thus, there would be no need of Ramun’s shim to adjust the distance between the guide and the upper jaw.

Indeed, combining Ramun’s shim with LaBounty would make LaBounty inoperative, because the presence of the shim would prevent the complete adjustment of clearance distance by turning the bolt ends with a wrench.

The Examiner has not shown that the shim of Ramun would provide any better clearance adjustment than that shown in LaBounty, given LaBounty’s mechanism for clearance adjustment.

Thus, the Examiner has not satisfactorily shown a motivation to combine the references.

Claim 1 is thus allowable.

Claims 2-11 contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claim 12 is allowable for the reasons given above in regard to claim 1.

Claims 13-17 contain additional elements or limitations beyond allowable claim 12 and are also allowable.

Furthermore, the Examiner has not specifically indicated where LaBounty shows the claimed pockets of claims 5, 11, and 16. Figure 7 of LaBounty shows the blade stabilizing device 68 penetrating the first mounting plate 26 and second mounting plate 28 without any suggestion

of "pockets" receiving the guide of the present invention, as clearly shown in Figure 2 (see ref. numeral 86 and 92).

Applicant thanks the Examiner for indicating the allowable subject matter.

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

Dated: 4 Oct 06

Respectfully submitted,

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